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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/536,943

10/17/2005

Anthony Denis McCormack

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EXAMINER

NGUYEN, PHU HOANG

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

08/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/536,943</p>	<p>Applicant(s) MCCORMACK, ANTHONY DENIS</p>	
	<p>Examiner PHU H. NGUYEN</p>	<p>Art Unit 1791</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed 7/27/2009 have been fully considered but they are not persuasive.

Applicant essentially argues that the cited prior art of Bereman discloses activated carbon which has a micropore volume is produced by peat and coal materials while activated carbon which has a mesopore volume is produced from coconut shells but does not disclose a carbon source that could produce both mesopores and micropores as claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., one carbon source could produce both mesopores and micropores in the claimed volume) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, upon further consideration, the Examiner found that Bereman discloses activated carbon may be obtained from a variety of sources and these activated carbon can have macroporous, mesoporous and microporous.

Applicant argues that currently presented claims require the presence of micropores, therefore the Applicant respectfully disagrees with the Examiner's position that currently presented claim 1 reads on a zero micropore volume. This argument is not persuasive because currently presented claim 1 states: "a micropore volume provided by micropores of under 2 nm pore diameter of at most 0.3 cubic cm/g", this recited claim does not exclude zero for the pore diameter or the volume. If the Applicant does not wish the claim language to include zero, it is suggested the Applicant recites such feature (i.e. from greater than 0) in the claim.

Applicant essentially argues that Bereman is silent about the volume of the pores and the secondary reference of Garrido only teaches controlling the porosity of activated carbons for use in different types of applications but does not suggest any particular type of porosity is more advantageous in one utility as opposed to another; therefore the combination of Bereman and Garrido does not yield claimed invention. However, as discussed in the Office Action filed 3/23/2009, since Bereman does is silent about the volume of the pores, it would have been obvious to one of ordinary skill in the art at the time the invention was made to look for a teaching in controlling the volume of the pores (such as the teaching provided by Garrido). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of Garrido to manipulate the pore volume (as shown on fig. 2) of the activated carbon pores to achieve a desired adsorption property.

Applicant essentially argues that the reference of Baur is concerned with a different process of using the activated carbon and preferred activated carbon with exclusive macropores therefore it teaches away from the present invention. Upon further consideration, the Examiner found that the Baur reference was shown as evidence that macropores of activated carbon is well known to a property such as have surface area in the range that is overlapping with the claimed range; therefore, it would have been obvious to one having ordinary skill in the art to have selected the portion of the surface area that corresponds to the claimed range.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant essentially argues that although the reference of Hershe does not suggest that an activated carbon filter used in filtering tobacco smoke could simultaneously absorb vapor phase components contained in tobacco smoke and still adequately release a flavorant. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an activated carbon filter used in filtering tobacco smoke could simultaneously absorb vapor phase components contained in tobacco smoke and still adequately release a flavorant) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, as discussed in Office Action filed 3/3/2009, the reference of Hershe teaches cigarette filter comprising menthol and other smoke flavoring agents with the activated carbon. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to put menthol flavor in the filter of Berman to give user the flavor.